

REMARKS/ARGUMENTS

Claim 1 is requested to be amended to insert a recitation itemizing and restricting the silicon-aluminum mixed oxide powders to the four types of silicon-aluminum mixed oxide powders individually recited in original Claims 2, 3, 4 and 5 and recited as a Markush grouping in previously amended Claim 14. The claims will remain as 1-23.

Also accompanying this amendment are terminal disclaimers with respect to U.S. Patent Nos. 6,455,455 and 6,905,632 (application 10/354,969).

With respect to the claim rejections on 35 U.S.C. § 102 of Claims 1-7, 14-16 and 20-23 under 35 U.S.C. § 102(b) as being anticipated by each of Mangold et al. (EP 1048617) and Deller et al. (U.S. 6,455,455), Applicants request reconsideration and withdrawal for the reasons presented on pages 7 and 8 of the previous response filed August 24, 2005.

The present amendment to Claim 1 simply restricts its scope to an itemization of powders recited in Claims 2 to 5.

As pointed out previously, the powders of Mangold (EP '617) and Deller (105-455) are the starting materials from which the powders of the subject broad Claim 1 are made by applying to the former the recited dispersing energy input of 200 KJ/m², not disclosed in the reference documents.

Hence, there is no anticipation of base Claim 1 and of Claims 2 to 6, 16 and 20 to 23 dependent thereon, directly or indirectly, nor of Claims 14 to the process of applying such energy, nor of Claims 7 and 15 dependent on 14.

The purpose of the application of such energy is to obtain a dispersion of good stability in the basic (even at high concentrations of aluminium oxide) and acidic pH ranges of mixed oxide particles (this application, page 8, line 21 to page 9, line 9) and which has improved selectivity for metal coatings on oxide surfaces in polishing.

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The subject application incorporates EP-A 1048617, and also DE-A-19847161, by reference. (This application, page 3, the sentence at line 18, and page 4, first sentence). The former is the Mangold EP document relied upon as basis for the rejection and Deller (U.S. 6,455,455) is the corresponding U.S. document.

Clearly, since the above are starting materials for the present product (please note the paragraph at page 10, line 15), the products are not identical, note the Examples, particularly examples for production of diffusions 1 to 3, pages 11 and 12, of the subject application.

Accordingly to Mangold et al. (EP 617, Par [0003] and the corresponding disclosure in Deller et al. (U.S. 6,455,455), col. 1, the paragraph at line 23, the particles they obtain are shown by x-ray defraction to consist of intergrown, “zusammengewachsenen,” primary particles in which crystallites are present. The present claims recite the dispersion of those primary particles and the high energy input required for its production, the paragraph at page 4, last paragraph of the subject application.

Concerning the rejection of Claims 1-2, 4-5, 7-9, 14-17 and 20-22 under 35 U.S.C. § 102(e) as being anticipated by Pryor (U.S. 6,294,106), Applicants refer to the previous response, page 9 over to page 10, presenting their position in favor of allowability.

The Advisory Action appears, in fact, to concede lack of anticipation, by its reliance on the decision of In re Susi, 440 F2d 442,169 USPQ 423 (CCPA 1971), copy enclosed. The decision relates to the issue of obviousness not anticipation and is therefore not supportive of the present rejection. There are no nonpreferred alleged anticipatory embodiments in Pryor nor is its broader disclosure anticipatory.

Concerning the 35 U.S.C. § 103 rejections, Applicants maintain their position in favor of patentability of the rejected claims previously stated. Essentially, these rejections stand or fall with the relevance of Mangold (EP-617) as anticipatory.

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Application No. 10/078,373
Second Reply to Office Action of May 4, 2005;
following Advisory Action of August 29, 2005

Concerning the obviousness type double patenting rejection, Applicants overcome them by the accompanying terminal disclaimers, in order to simplify the issues. It is noted that Application Serial Number 10/354,969 has issued as U.S. 6,905,632.

Entry of the present amendment for purposes of appeal, in addition to the previously submitted amendment, is requested as not increasing the number of claims and as simplifying the issues.

Respectfully submitted,

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strict but also make it clear that transfer of these cases to a single district for coordinated or consolidated pretrial proceedings will serve the convenience of the parties and their witnesses and will promote the just and efficient conduct of this litigation.

Of the eight real parties in this litigation, four either reside in or have a principal place of business in the Central District of California while two of the remaining four parties have a principal place of business in the Southern District of California and are represented by counsel with offices in the Central District of California. In addition, five of the seven attorneys active in this litigation maintain offices in the Central District of California and the inventor of the patent, John W. Sellner, resides in the Central District of California.

The responding parties also contend that many of the activities relating to the validity of reissue patent No. 26,725 occurred in California and that much of the discovery will be directed to the business records and other tangible evidence in the possession of Embro Company, Inc. and Mr. Sellner. In further support of transfer to the Central District of California, it is pointed out that the earliest case, Relaxaway Corporation v. Embro Co., Inc. was commenced in that district.

We are satisfied from the above uncontested allegations that there is substantial common discovery in the area of patent validity and that the transfer of these actions to the Central District of California will serve the convenience of the parties and their witnesses and will promote the just and efficient conduct of this litigation.

It is therefore ordered that the actions on the attached Schedule A pending in other districts be and the same are hereby transferred to the Central District of California for coordinated or consolidated pretrial proceedings under 28 U.S.C. § 1407. With the written consent of that court, all such actions are hereby assigned to the Honorable Francis C. Whelan.

SCHEDULE A

SOUTHERN DISTRICT OF CALIFORNIA

Embro Co., Inc. v. House of Slender Gem, Inc. Civil Action No. 70 127 T
 Embro Co., Inc. v. Daco Industries, Inc. Civil Action No. 70 165 T

CENTRAL DISTRICT OF CALIFORNIA

Relaxaway Corporation v. Embro Co., Inc., et al. Civil Action No. 69-2393-FW

Embro Co., Inc. v. Tube Specialists, Inc. Civil Action No. 70-844-DWW

DISTRICT OF OREGON

Embro Co., Inc., et al. v. Robert J. Thomas, etc. Civil Action No. 70-225

WESTERN DISTRICT OF WISCONSIN

Embro Co., Inc. v. JTL Manufacturing, Inc., et al. Civil Action No. 70-C-112

STANLEY A. WEIGEL, Judge of the panel, dissenting:

I respectfully dissent. As in *In re Carrom Trademark Litigation*, 322 F.Supp. 1016, 168 USPQ 714 (J.P.M.L. 1971), and *In re Willingham Patent Litigation*, 322 F.Supp. 1019, 168 USPQ 713 (J.P.M.L. 1971), it seems to me that there are insufficient common questions of fact to justify § 1407 transfer in the light of the troubles and inconveniences occasioned thereby. See *In re "East of the Rockies" Concrete Pipe Antitrust Cases*, 302 F.Supp. 244, 253-256 & n. 1 (J.P.M.L. 1970) (concurring opinion); *In re Butterfield Patent Litigation*, — F.Supp. —, 165 USPQ 310, 313 (J.P.M.L. 1970) (dissenting opinion).

Court of Customs and Patent Appeals

In re Susi

No. 8392

Decided Apr. 22, 1971

PATENTS

1. Patentability — Composition of matter (§51.30)

Combination, for same purpose, of one additive explicitly disclosed in prior art and another suggested by prior art is at least *prima facie* obvious.

2. Specification — Sufficiency of disclosure (§62.7)

One is not significantly taught away from a particularly preferred embodiment by suggestion, whether true or false, that something else may be even better.

Particular patents—Polymers

Susi, Light Stable Polymers, claims 2 to 13 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Peter Vincent Susi, Serial No. 389,210, filed Aug. 12, 1964; Patent Office Group 140. From decision rejecting claims 2 to 13, applicant appeals. Affirmed.

WILLIAM KAUFMAN, HARRY H. KLINE, and ROLAND A. DEXTER, all of Stamford, Conn., for appellant.

S. WM. COCHRAN (R. E. MARTIN of counsel) for Commissioner of Patents.

Before RICH, ALMOND, BALDWIN, and LANE, Associate Judges, and NEWMAN, Judge, United States Customs Court, sitting by designation.

RICH, Judge.

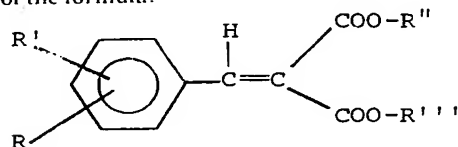
This appeal is from the decision of the Patent Office Board of Appeals affirming the examiner's rejection of claims 2-13 in appellant's application serial No. 389,210, filed August 12, 1964, as a continuation-in-part of application serial No. 362,182, filed April 23, 1964, for polymers stabilized against the deteriorative effects of ultraviolet light and a method for making polymeric compositions so stabilized. We affirm.

The Invention

Claims 2-5 are process claims, and claims 6-13 are composition of matter claims. Claim 6, the broadest of the composition claims, serves as a convenient introduction to the case and reads as follows (subparagraphing supplied):

6. The composition of a polymer selected from the group consisting of polyvinylchloride, polyvinylidene chloride, polymethylacrylate, polymethylmethacrylate, polystyrene, melamines, polyesters and polyolefins and polyolefins and

0.01 to 2 weight percent of a compound of the formula:



wherein

R and R' are individually selected from the group consisting of hydrogen, hydroxy, alkoxy of 1-12 carbons, alkyl of 1-12 carbons, alkenyloxy of 2-12 carbons and alkenoyloxy of 2-12 carbons; and

R'' and R''' are individually selected from the group consisting of alkyl of 1-12 carbons, monocyclic aryl and monocyclic ar (lower alkyl).

Claim 2 recites the process of stabilizing a polymer selected from the same group of polymers recited in claim 6 by "adding" thereto "a stabilizing amount" of one of the same benzylidene malonate acid di-esters recited in claim 6. Claims 3 through 5 depend from claim 2, and claims 7 through 10 depend from claim 6. Claims 3 and 7 specify that the polymer is polyvinylchloride, claims 4 and 8 specify that the polymer is polystyrene, claims 5 and 9 specify that the additive is diethyl *p*-methoxybenzylidenemalonate, and claim 10 specifies that the additive is dimethyl *p*-methoxybenzylidenemalonate. Claims 11 through 13 recite an additional additive. Claim 11 is for "The composition of Claim 6 containing about 0.1 to 1 part of hindered phenolic antioxidant for each part of * * * [the additive recited in claim 6]." Claim 12 depends from claim 11 and specifies that the di-ester additive is dimethyl *p*-methoxybenzylidenemalonate and the antioxidant is 2,4,6-tri-*t*-butylphenol. Claim 13, which is in independent form, is for polystyrene stabilized by the two additives of claim 12 in the amounts recited in claim 12. The arguments for patentability have been predicated solely on the additives, and not on the specific plastics to which they are added.

The References

The references are:

Lauerer et al. (West German Auslegeschrift)	1,087,902	Aug. 25, 1960
Costello	3,134,751	May 26, 1964
Knapp et al.	3,244,668	Apr. 5, 1966

Appellant initially attempted to swear behind Lauerer and Knapp. However, both the examiner and the board held his showing insufficient, and appellant has conceded that point on appeal.

The Rejection

The examiner rejected claims 2 through 11 as unpatentable over Knapp et al. under the provisions of either 35 U.S.C. 102 or 103, claim 2 through 10 as similarly unpatentable under either 35 U.S.C. 102 or 103 over Lauerer, claims 11 through 13 under the provisions of 35 U.S.C. 103 on either Knapp or Lauerer, each in view of Costello, and claims 2 through 5 as "drawn to the obvious method of making the composition under 35 U.S.C. 103."¹ The board reversed the rejections under 35 U.S.C. 102, stating that it

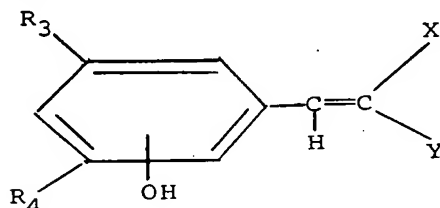
¹ This rejection has raised the interesting issue, which the parties have argued but which we do not reach because of our affirmance of the other rejections, of the continued validity of *In re Larsen*, 49 CCPA 711, 292 F.2d 531, 130 USPQ 209 (1961).

"was unable to find the exact stabilizing compound of these claims in Knapp et al. or any one of the specific resins of these claims in Lauerer et al.," but it affirmed the other four rejections.

Opinion

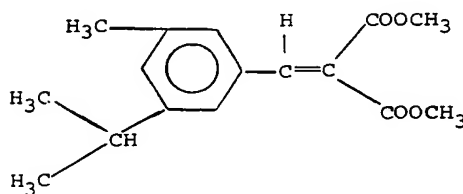
Prima Facie Obviousness

Knapp discloses the stabilization of "plastics" against the oxidative and deteriorative effects of ultraviolet light by adding thereto "a small stabilizing quantity, up to about 5 percent, and preferably from 0.001 to about 3 percent" each of two compounds. The first of these additives is either a nitrophenol or a formylphenol, which is not relevant here. The second of these additives, however, is a compound which, in a "particularly preferred embodiment," may be represented by the formula:

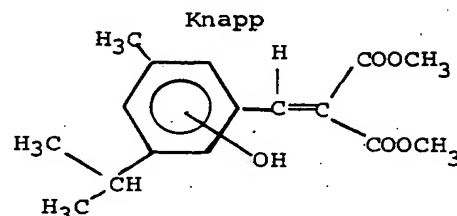


wherein R_3 is an alkyl radical containing from 1-12 carbon atoms; R_4 is an alpha-branched alkyl radical containing from 3-12 carbon atoms; and X and Y are selected from the group consisting of a cyano radical, a nitro radical, $\text{CON}(\text{R})_2$, COOR , and COR , R in turn being selected from the group consisting of hydrogen, alkyl radicals containing from 1-12 carbon atoms, and aralkyl radicals containing from 7-12 carbon atoms, with the provision that either X or Y, but not both, can also be simply H. Placing a simple representative of each side by side, it is obvious that the subject matter of appellant's claim 6 is very nearly within the generic teaching of Knapp.

Appellant

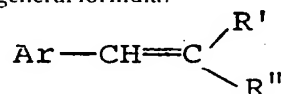


in view of *In re Tarczy-Hornoch*, 55 CCPA 1441, 397 F.2d 856, 158 USPQ 141 (1968).



Furthermore, the one difference which is present seems to be of little importance. Knapp shows a hydroxyl group attached to the benzene ring which is absent in appellant's formula, but, as the examiner noted without challenge by appellant, the "appellant has shown no unobvious results by excluding this moiety." Accordingly, as to claims 1-10 appellant is essentially in the position of one who argues that the selection of a relatively small subgenus from a genus disclosed in the prior art would have been unobvious at the time of his invention to one skilled in the art.²

Lauerer discloses plastic compositions containing ultraviolet light absorbers of the following general formula:



wherein Ar is a benzene ring substituted by one or more oxy or alkoxy groups and is admitted by appellant to be the same as the left-hand side of his composition, as depicted in claim 6, supra; R' is selected from a group consisting of CN, COOH, COX, $(\text{CH}_2)_n\text{COOH}$ and $(\text{CH}_2)_n\text{COOR}$; R'' is selected from a group consisting of H, R, CN, COX, and COOH, where X is alkyl, aryl, substituted alkyl, substituted aryl, OR, RNR, NHR, or NH_2 , and R is H, alkyl, aryl, substituted alkyl, or substituted aryl cycloalkyl, n being a whole number such as 1 or 2. As appellant points out, Lauerer's disclosure is huge, but it undeniably includes at least some of the compounds recited in appellant's generic claims and it is of a class of chemicals to be used for the same purpose as appellant's additives. Thus, whether considered in view of Knapp or Lauerer, appellant's claims 1-10 are prima facie obvious.

² In the compounds recited in appellant's species claims (diethyl *p*-methoxybenzylidenemalonate in claims 5 and 9 and dimethyl *p*-methoxybenzylidenemalonate in claim 10) there would be a methoxy group at the para position in the benzene ring which is not within the Knapp disclosure. However, appellant has not argued that his species claims are not prima facie obvious if his generic claims are.

[1] Costello teaches the protection of polystyrene from ultraviolet light-induced deterioration by the addition of a trialkyl phenol. In particular, he discloses, as the best of the specific examples given, 2,4,6-tri-*t*-butyl phenol, recited in appellant's claims 12 and 13. The solicitor has conceded that if we reverse the rejection of claims 2-10, "the reversal of * * * [claims 11-13] would follow as a matter of course." Appellant has not conceded that affirmance of the rejection of claims 11-13 would similarly follow upon affirmance of the rejection of claims 2-10, emphasizing that Costello is "completely devoid" of any suggestion of using his phenolic antioxidants in combination with appellant's benzylidene malonic acid di-esters, but we agree with the solicitor that the combination, for the same purpose, of one additive explicitly disclosed in the prior art and another suggested by the prior art would be at least *prima facie* obvious.

Objective Evidence of Non-Obviousness

The appellant did not submit the usual Rule 132 affidavits comparing representative samples of his claimed compounds with representative samples of the compounds disclosed in the references. Instead, he has relied on tables in the application as filed which ("fortuitously," according to his oral argument) compare samples of his claimed compounds with three specific compounds disclosed in Knapp and one disclosed in Lauerer. The Patent Office has not contended that the type of tests, results of which were compared, are not appropriate or that these tables do not show that the samples of appellant's additives are much better stabilizers than the species with which they were compared. The issues here are thus whether appellant's data establish (1) the degree of effectiveness of the prior art additives *as a class* and (2) the degree of effectiveness of the additives recited in appellant's generic claim *as a class* and of the additives recited in appellant's species claims specifically.³ Without this information, there is simply no way of telling whether appellant's

[2]³ Appellant also argues that Knapp teaches away from his invention because, while the formula set forth in the discussion of Knapp, *supra*, is referred to as a "particularly preferred embodiment," Knapp terms a particular subclass of the compounds represented by that formula, which subclass is not as close structurally to appellant's additives as are other species within the "particularly preferred" class, his "most particularly preferred embodiment[s]." We cannot accept the suggestion that one is significantly "taught away" from a "particularly preferred embodiment" by the suggestion (whether true or false) that something else may be even better.

relatively small class of additives is superior, as a class, to the much larger classes disclosed by Knapp and Lauerer.

Unfortunately for appellant, Knapp and Lauerer do not quantify their results.⁴ Thus, to overcome a finding of *prima facie* obviousness by establishing that the claimed compositions are superior to what one of ordinary skill in the art would expect, it was up to appellant to bring forward reasonable evidence concerning the light-stabilizing properties of the prior art as well as concerning the light stability of the claimed composition. This he did not do, and we find this failure fatal, not only to his generic claims (2 through 4 and 6 through 8), but to his species claims (5, 9, and 10) as well, for appellant has given us nothing (or at least not enough) with which to compare the effectiveness of diethyl and dimethyl *p*-methoxybenzylidenemalonate. As for claims 11 through 13, in which both a benzylidene malonic acid di-ester and an antioxidant are recited, for the reason set forth *supra* we find them *prima facie* obvious, and we see no evidence at all directed to establishing their individual nonobviousness. Thus, their rejection is likewise affirmed.

Court of Customs and Patent Appeals

In re RUSSELL

No. 8478

Decided Apr. 22, 1971

PATENTS

1. Prior adjudication — Applications for patent (§56.05)

In re Herr, 153 USPQ 548, is not distinguished even if applicant might have presented in parent application evidence later presented in instant continuation application; applicant has made a new record, presenting different questions of patentability even if claims are viewed as identical to those in parent application, which resulted in dismissal of civil action with prejudice as to claims in parent application but without prejudice as to claims which might be allowed in continuation application; *res judicata* rejection is reversed.

⁴ According to Knapp, compounds of the formula set forth *supra* are "particularly preferred" because of their "excellent ultraviolet light absorbency capacity." According to Lauerer, compounds of the formula set forth *supra* are "especially well suited" to protecting light-absorbent compounds such as plastics from ultra-violet radiation.